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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,685	12/22/2005	Dieter Hermeling	29827/41757	1354
4743 7590 04/03/2009 MARSHALL, GERSTEIN & BORUN LLP 233 SOUTH WACKER DRIVE 6300 SEARS TOWER CHICAGO, IL 60606-6357			EXAMINER TRUONG, DUC	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 04/03/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/561,685

**Applicant(s)**

HERMELING ET AL.

**Examiner**

Duc Truong

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 and 8-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date (533006)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

### **DETAILED ACTION**

In the response to the restriction requirement, Applicant elects group III, claims 5 and 8-12, directed to a swellable hydrogel forming polymer, embrace the composition of group I, claims 1-3.

In the condition if the composition of group III is in condition for allowance, then the composition of group I, claims 1-3 will be rejoined and be allowed also.

Further, group II, claim 4, and group IV, directed to a process for preparing the polyol ether of group I and the process for preparing a crosslinked swellable hydrogel forming polymer of group III, will be rejoined and be allowed also.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 5 and 8-12 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 03/095496 of record on 1449.

The reference discloses active carbohydrate containing protective reagents represented by a carbohydrate central unit, which is attached to a polymer chain at least one of the hydroxyl groups and to an active linkage group at the anomeric position of the carbohydrate unit, and their use for production of biologically active molecules (see Abstract; page 3, line 8 to page 8, line 4; claims 1-19; examples 1-3).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5 and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0997507 or WO 01/00259 or WO 93/21237 or US 6080816 OR US 5854386 or US 6417425 or US 6350710, they are of record on 1449.

EP 0997507 discloses an amino functionalized polyetheracrylates as radiation curable compound comprising unsaturated urethane, epoxy, polyether and polyester (met)acrylates---(see Abstract, [0055-0066]; claims 1-14, examples 1-2);

WO 01/00259 discloses a web of superabsorbent polymer comprising unsaturated carboxylic acid group, monomers such as acrylamide, maleic acid, anhydride, esters---(see Abstract; page 5, line 13 to page 9, line 5; claims 1-13; examples A-I);

WO 93/21237 discloses a crosslinked carboxyl containing hydrophilic resin prepared by contacting one or more ethylenically unsaturated carboxylic acid, or salts, one or more comonomers of an acrylamide, vinyl pyrrolidone, cellulosic monomer---

and a crosslinking compound---(See Abstract; page 3, line 3 to page 6, line 34; claims 1-11; and the examples 1-38);

US 6080816 discloses a copolymer composition having an acrylic polymer base backbone comprising ethylenically unsaturated monomer, the backbone being insoluble and the arms being soluble in the composition, a melamine crosslinker and an acrylic polyol---(See Abstract; col. 1, line 30 to col. 3, line 30; claims 1-25 and examples 1-10);

US 5854386 discloses polyethers containing both hydroxyl functionality and unsturation functionality prepared by oxyalkylating an unsaturated monomer having at least one oxyalkylatable hydrogen under cited conditions (see Abstract; col. 2, line 48 to col. 4, line 47; claims 1-29; examples 1-4);

US 6417425 discloses a fibrous web a blend containing superabsorbent forming monomer, initiator and water, and subjecting the web to polymerization condition in that reactants and the cited conditions are disclosed (see Abstract; col. 2, line 45 to col. 5, line 65; claims 1-4 and examples 1-20)

US 6350710 discloses superabsorbent polymers composition comprising fibers such as polyolefins, polyacrylates, polyamides, polyesters---(see Absytract; col. 5, line 32 to col. 8, line 26; claims 1-22, examples 1-21).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 8-12 are rejected under 35 U.S.C. 102(e or b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over references cited above.

The disclosures of the references differ from the instant claims in that they do not disclose the general formula (I) in claim 1.

However, the compositions disclosed by the references are prepared from reactants and under process conditions that are inclusive of the claimed reactants and conditions. In view of this similarity, it would appear to be inherent that the product having the claimed formula could be considered inherent in the prior art. See *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Truong whose telephone number is 571-272-1081. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Duc Truong/  
Primary Examiner, Art Unit 1796